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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/539,730

06/20/2005

Ansgar Behler

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09/28/2006

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

NAGUBANDI, LALITHA

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/539,730

Applicant(s)

BEHLER ET AL.

Examiner

Lalitha Nagubandi

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) 11, 13-15, 17-20, 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 26 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Office Action***Status of the Claims***

Claims 25-32 are pending in this application. Claims 27 –29 have been cancelled. Claims 25,26 and 30-32 are considered for examination in this office action.

Election/Restriction

Applicant's election of Group III (claims 25-30) in the reply filed on July 24th 2006 is acknowledged. Claims 1-10, 12,16 and 21-24 and 27-29 have been cancelled. Claims 11, 13-15,17-20,33 and 34 are withdrawn from consideration as not being directed to a non-elected Group.

Response to Argument

Applicants' remarks in response to the previous office action dated April 24th, 2006 regarding restriction requirement has been noted and the arguments were not found persuasive. Claims 11, 13-15,18 (Group I) are directed to a process for the production of a mixture hydroxy carboxylic acids and Claims 19 and 20 (Group II) are directed to a composition comprising, a mixture of carboxylic acid and its esters. Group I, II and III lack the same technical feature as in group III the claims are directed to a cosmetic composition. Thus the inventions listed as groups I, II and III do not relate to a single general inventive concept. Hence, the election requirement is made **FINAL**.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

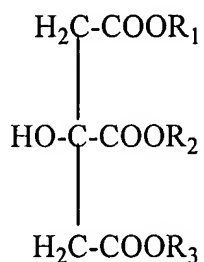
Claims 25,26, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnebien et al (US Pat. No. 6,024,947 dated Feb. 15, 2000).

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Applicants claim a cosmetic composition comprising: one or more active ingredients and a mixture of mono, di, and triesters of citric acid and optionally free citric acid.

Determination of Scope and content of the Prior Art (MPEP§2141.01)

Gagnebien et al teach (see: col. 5 lines 20 -25 Formula (I) US Pat. No. 6,024,947 dated Feb. 15, 2000) cosmetic compositions of citric acid esters having improved rinsability.



Formula (I)

Ascertainment of the difference between the Prior Art and Claims (MPEP §2141.02)

The difference between the instant compounds and Gagnebien et al is that the instant cosmetic composition requires 2 to 10 parts ethylene oxide per alkyl group of the ethoxylated alkyl group present in the ester component.

Finding of prima facie obviousness – rational and motivation (MPEP § 142-2143)

It is sufficient if a reference composition is so closely related to claimed composition that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the presence of the ethylene oxide content.

Therefore the subject matter as a whole would have been obvious to one of ordinary skill in the art and one would have been motivated to modify the cosmetic composition cited above at the time of invention, and the ordinary artisan would have had a reasonable expectation of success and hence it is a prima facie obvious.

Conclusion

No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996. The examiner can normally be reached on 6.30am to 3.30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571 272 0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lalitha Nagubandi
Patent Examiner
Technology Center 1600

August 24th, 2006.


THURMAN K. PAGE
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Technology Center 1600